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Recons.

PATENT 4-24-02
Customer No. 22,852
Attorney Docket No. 02734.0506-00

L. Spruell

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Kambiz B. MAKOUUI et al.) Group Art Unit: 2854
Application No.: 08/733,072) Examiner: R. Yan
Filed: October 16, 1996)
For: EMBOSSING SYSTEM)
INCLUDING SLEEVED ROLLS)

Commissioner for Patents
Washington, DC 20231

Sir:

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REQUEST FOR RECONSIDERATION

In reply to the Office Action dated November 9, 2001, the period for reply having been extended for two months by a request for extension and fee payment filed concurrently herewith, Applicant requests reconsideration of this application in view of the arguments previously made and further set forth below.

Currently, claims 1-10, 18-22, 25-30, 33-41, 49-61, 69-72, and 75-77 are pending in the application. Claims 22 and 25-30 have been withdrawn from consideration by the Examiner. In the Office Action, the Examiner rejects under 35 U.S.C. § 103(a) all remaining claims, namely claims 1-10, 18-21, 33-41, 49-61, 69-72, and 75-77.

Applicants respectfully traverse the Examiner's rejections.

The above claims are rejected as obvious over a number of combinations of prior art references. Claims 1, 2, 8, 9, 18, 19, 33, 34, 49, 50, 53, 54, 60, 69-72, and 75-77 are rejected under § 103(a) as obvious over U.S. Patent No. 3,731,620 to Klemmer in

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view of U.S. Patent No. 4,685,393 to Saueressig, European Patent Application Publication No. 181,726, and U.S. Patent No. 5,266,257 to Kildune. Claims 20, 21, 51, 52, 71, and 72 are rejected as obvious over the above references further in view of U.S. Patent No. 4,144,813 to Julian. The Examiner rejects claims 3-7, 35-40, and 55-59 over Klemmer in view of Saueressig, EP 181,726, and Kildune. Finally, claims 10, 41, and 61 are rejected over the above references further in view of U.S. Patent No. 3,404,254 to Jones.

In all of the separate rejections set forth above, the Examiner relies on a combination of at least Klemmer with two other references, Saueressig and EP 181,726. According to the Examiner, Klemmer teaches "the very concept as disclosed and claimed in the present application to use a releasably attached sleeve ... on an embossing roller core." Office Action at 2. The Examiner goes on to state that Klemmer "may not disclose in detail how the embossing sleeve is releasably mounted." *Id.* This is clearly not true, as Klemmer specifically states that the sleeve is attached through the use of bolts which hold the sleeve to the core. See Klemmer at col. 7, lines 46-66. Klemmer in no way teaches or suggests the apparatus of the present invention, which involves the use of pressurized air to releasably attach the sleeve to the core.

To supply the teachings not found in Klemmer, the Examiner resorts to two references from the printing art, namely Saueressig and EP 181,726. According to the Examiner, Saueressig describes a method of releasably attaching a sleeve to a core using pressurized gas, while EP 181,726 discloses the use of a keyway on the core to prevent rotation of the sleeve on the core. Office Action at 2-3. Furthermore, the

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Examiner relies on the disclosure of Kildune to supply the claimed embossing elements.
Office Action at 3.

Applicants have previously argued to the Examiner that the rejection of the claims using a combination of Klemmer with Saueressig and EP 181,726 is improper, since two of the cited references are drawn from nonanalogous art and therefore cannot be combined to render the present invention obvious. Both Applicants and the Examiner have recognized the teachings of *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992), which states that the references must either be in the field of Applicants' endeavor, or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned. Because neither of these conditions are satisfied in the case of the Saueressig or EP 181,726 references, these references cannot properly support the Examiner's obviousness rejection.

In the prior Final Office Action of October 11, 2000, the Examiner rejected Applicants' arguments regarding the above. The Examiner first stated that the cited references are all drawn from the field of Applicants' endeavor, the printing art. Final Office Action at 6. According to the Examiner, embossing is a subset of printing in general, because it is classified under the same class in the U.S. Patent Classification System as printing. *Id.* Applicants respectfully submit that the Examiner cannot rely solely on this evidence to support a finding of analogous art. "While Patent Office classification of references ... are some evidence of 'nonanalogy' or 'analogy' respectively, the court has found 'the similarities and differences in structure and function of the inventions to carry far greater weight.'" See MPEP § 2141.01(a) (citing *In re Ellis*, 476 F.2d 1372 (C.C.P.A. 1973).

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The Examiner, in the Final Office Action, went on to state that the teachings of Saueressig and EP 181,726 are "extremely pertinent" to the problem confronted by Applicants, namely "facilitat[ing] the mounting and removing the sleeve on or from the roller core and to prevent rotation of the sleeve ... when subjected to high printing pressure." Final Office Action at 6. Applicants submit that the Examiner's statement ignores the fact the embossing and printing, while superficially seeming to be related, actually present very different technical problems. The printing art cannot be said to be analogous to the embossing art, because solutions which may work in the printing art cannot automatically be implemented in the embossing art. For this reason, those seeking to solve problems encountered in the embossing art would not necessarily turn to the printing art for solutions.

As has been noted by Applicants before, the technical problems confronted in the printing and embossing arts are quite different because of the different conditions in which embossing and printing are carried out. In the printing art, printing plates having type are coated with ink. During the printing operation, the ink is physically transferred from the type portions of the printing plate to the web of material. The type portions of the printing plates are not depressed - or embossed - into the web of material.

In complete contrast to the cited references and to printing plate technology in general, Applicants intend to and do apply the relief contours formed on its embossing roll to the web of material. As amended, all claims require that the embossing elements on the sleeve have at least one of curvilinear side walls, spherical surfaces, and multiple elevations. In order to apply patterns shaped in these ways to a material, the embossing roller and backup roller must come into contact with pressures that far

exceed the pressures encountered in the printing art, in which the roll merely has to contact the material to transfer ink. As has been noted before, the pressures involved with embossing these types of patterns can range from 100 to 120 pli, more than two orders of magnitude greater than printing processes which apply only 1 to 5 pli.

Applicants believe that the above arguments fully establish that the printing and embossing arts are separate and nonanalogous, and that the problems confronting those working in the embossing art are far different than those which confront those in the printing art. For these reasons, Applicants respectfully submit that the obviousness rejections as set forth in the Office Action are improper, because they combine references from nonanalogous art. However, if the Examiner believes that these facts are insufficient, or if he would prefer that Applicants submit these facts to the Office in the form of an inventor's declaration under 37 C.F.R. § 1.132, he is invited to contact Applicants' undersigned representative to discuss this matter.

In view of the foregoing remarks, Applicants respectfully request the reconsideration and continued examination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

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Respectfully submitted,

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Dated: April 9, 2002

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